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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,604	08/18/2003	John Wallace Nasielski	030277	5063
23696	7590	10/14/2010	EXAMINER	
QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				NGUYEN, QUYNH H
2614		ART UNIT		PAPER NUMBER
			NOTIFICATION DATE	
			DELIVERY MODE	
			10/14/2010	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com

Office Action Summary	Application No.	Applicant(s)	
	10/643,604	NASIELSKI ET AL.	
	Examiner	Art Unit	
	QUYNH H. NGUYEN	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-7,9-12,15-18,20-25,27-29 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,5-7,11,12,16-18,22-25,27,29,32 and 34-39 is/are rejected.
- 7) Claim(s) 4,9-10,15,20-21,28, and 33 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1, 5-7, 11-12, 16-18, 22-25, 27-29, and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmad et al. (2002/0082029) in view of Kleinfelter et al. (2005/0094779).

As to claims 1, 12, 23-24, and 34, Ahmad teaches a method of wireless communication comprising:

establishing a packet data session from a wireless communications device to support a network connection to a packet switched network (paragraphs [0007]; [0024]);
registering from the wireless communications device over the packet data session with a voice message server (*Internet Call -Waiting Server*) to receive the notification (paragraph [0039]);

transmitting a registration request and the registration request from the wireless communication device, over the Internet to enable the wireless communication device to receive notification including connection information identifying the wireless communications device ([0039] - where Ahmad discussed the user of the hybrid mobile station must register over the Internet with the ICSW for the Internet call waiting notification, hence it would have been obvious that the registration request including

connection information identifying the wireless communication device in order to the ICWS notifies the subscriber via the Internet when there is a message left from the incoming call; furthermore, when the user invokes the service, the user registers over the Internet and device identification number has to be inputted to identify the device);

receiving a notification at the wireless communications device of an incoming call from an Internet Call -Waiting Server (paragraphs [0038] - [0039]) from a circuit switch network while the network connection is active (paragraphs [0035] - [0036],[0039]).

Ahmad further teaches the Internet Call Waiting Server sending notification to the subscriber via the Internet and wireless communication link that a voice call is waiting ([0039]). However, Ahmad does not explicitly teach enabling the wireless communications device to receive a notification from the voice message server.

In the same field of endeavor, Kleinfelter teaches receiving notification in the subscriber's communication device if the subscriber is currently occupying the telephone line accessing the Internet ([0034]) from a voicemail MWI wherein the MWI proxy server receives MWI information from the MWI server and notifies the subscriber's communication device ([0015]).

Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kleinfelter into the teachings of Ahmad for the purpose of providing notification to subscribers without the need for special software on the client's computer, as discussed by Kleinfelter ([0014]). Furthermore, it is well known that a server is a server and the server can be the Internet Call Waiting Server.

As to claims 5 and 16, Ahmad teaches the use of a transport control protocol session is considered to be implicit in a packet data session (paragraphs [0036] and [0038]).

As to claims 6-7, 11, 17-18, 22, and 27, Ahmad teaches terminating the packet data session in response to the notification of the incoming call, and accepting the incoming call from the circuit switched network; receiving the notification at the wireless device (paragraphs [0011], [0036] and [0039]).

As to claim 25, Ahmad teaches receiving notification at the wireless communications device over the packet data session (paragraphs [0036] and [0038]).

Claim 29 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, operating a wireless device in a serving network, the wireless device being assigned to a home network different from the serving network is known by the skilled person having assigned to a home network can be operating in visitor networks. The communications device is operating in a serving network different from the home network is merely one of several straightforward possibilities from which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill.

Claim 32 is rejected for the same reasons as discussed above with respect to claims 27, respectively and the first limitation of claim 29.

Claims 35, 36 are rejected for the same reasons as discussed above with respect to claims 24 and 29, respectively.

As to claims 37-39, Ahmad teaches connection information includes an IP address assigned to the wireless communication device ([0032] - where Ahmad discussed Internet call delivery server couple to communicate through IP network to deliver VoIP calls and relate signals, hence IP address included in the connection information).

Response to Arguments

3. Applicant's arguments with respect to claims 1, 5-7, 11-12, 16-18, 22-25, 27, 29, 32, and 34-39 have been considered but are not persuasive. Applicant's arguments with respect to claims 4 and 9 have been considered and are persuasive, as a result claims 4 and 15 are objected to, claims 9 and 20 and their dependent claims 10 and 21 are objected to, claims 28 and 33 are also objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (see further below for suggestions).

Applicant mainly argues that in Ahmad reference, it does not appear necessary for the user to register with the ICWS with the HMS itself and nothing in the reference suggests that the registration request including connection information identifying the wireless communication device is conveyed to the ICWS within the message that is sent to invoke registration of the HMS. Examiner respectfully submits that when the user invokes the service, the user registers over the Internet and device identification number has to be inputted to identify the device. Applicant further argues that Ahmad is silent

regarding when the user must perform the registration. Examiner respectfully submits that this not recite anywhere in the claims.

Applicant argues that in Ahmad, the registration “could very well occur prior to the data call being set-up. For example, the user could register for call-waiting service from the ICWS at any point before the data session...”. Examiner respectfully submits that Ahmad teaches the user register over the Internet ([0039]); and the claim does not required data call to be ongoing while registering.

Applicant argues that Ahmad and Kleinfelter do not teach receiving a notification from the voice message server. Examiner respectfully submits that the claimed voice message server does not do anything but sending notification. While Ahmad also teaches the Internet Call Waiting Server sending notification to the subscriber via the Internet and wireless communication link that a voice call is waiting ([0039]). It is well known that a server is a server and the server can be the Internet Call Waiting Server.

After further review, the examiner believes the following amendment would provide a more favorable outcome:

1. For independent claims 1, 12, 23-24, 29, and 34-36, first, amend to overcome prior arts of record, for example, in claim 1 last limitation receiving the notification, in the wirelesswhile the network connection to the packet-switched network is active, the packet-switched network change to the packet data session, second, incorporate the limitation of claim 4 into the independent claims mentioned above.

2. The preamble of claim 34, examiner suggests to amend “A tangible storage medium” to -- A non-transitory tangible storage medium -- because the broadest reasonable interpretation of the claims drawn to a computer readable medium typically covers forms of non-transitory tangible medium and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable medium. See MPEP 2111.01. When the broadest reasonable interpretation of claims covers a signal per se, the claims are rejected under 35 U.S.C. 101 as covering non-statutory subject matter. Suggestion is to amend to narrow the claim to cover only statutory embodiments.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUYNH H. NGUYEN whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quynh H Nguyen/
Primary Examiner, Art Unit 2614